

REMARKS

The Office Action mailed October 6, 2006, has been received and reviewed. Claims 1 through 4, 6, 7, 9, and 11 through 16, and 18 through 20 are currently pending in the application. Claims 9, 11 through 16, and 18 through 20 are withdrawn from consideration. Claims 1 through 4, 6, and 7 stand rejected. Applicants respectfully request reconsideration of the application.

35 U.S.C. § 102(b) Anticipation Rejections

Anticipation Rejection Based on U.S. Patent No. 6,291,127 to Dagan *et al.*

Claims 1 through 3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Dagan *et al.* (U.S. Patent No. 6,291,127) (hereinafter “Dagan”). Applicants respectfully traverse this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Regarding independent claim 1, Applicants assert that Dagan does not describe, either expressly or inherently, each and every element of claim 1 as recited in the claims to anticipate the claimed invention under 35 U.S.C. § 102. Dagan does not describe “the coated paperbase having . . . a Sheffield porosity less than approximately 10” or “the ink-receiving layer being present on the coated paperbase from about 3 grams per square meter to about 7 grams per square meter,” as recited in claim 1. The lowest porosity indicated on Table 1 of Dagan is 65. Column 20, lines 21 through 23, indicate that the porosity is Sheffield porosity. The Examiner contends that Table 1 does include values within the ranges instantly claimed, and refers to Example 5 to support this argument. However, the paper of Example 5 (used as a control) is laminated with polyolefin, which independently affects the surface and makes the paper less porous and, thus, less absorptive. In fact, Table 1 shows that Example 5 has a porosity of zero. In contrast, all of the pending claims require an absorptive paperbase. Thus,

Dagan does not describe a Sheffield porosity less than approximately 10. Additionally, the Examiner asserted that, as a general rule, 1 micron thickness of an ink-receiving layer converts to 1 gram of ink-receiving layer per meter squared of the surface to be coated. *Office Action mailed October 6, 2006, page 2*. The Examiner has not identified the source of this conversion factor or established that such a conversion is inherent. Further, the “1 micron thickness” language relates to a unit of length, whereas the phrase “1 gram per meter squared” relates to concentration or density, making the two terms nonrelated. Therefore, for at least these reasons, Dagan does not anticipate claim 1.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on Applicants’ admission in their 131 Declaration

Claims 1 through 4, 6, and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicants’ admission in their 131 Declaration. Applicants respectfully traverse this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants assert that a *prima facie* case of obviousness has not been established. Even if elements of the claimed invention were known, such an acknowledgement would not establish obviousness. The Examiner has not established a motivation to combine the allegedly known elements. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *M.P.E.P. § 2143.01*. (emphasis in original). Therefore, any admission by the Applicants in the 131 Declaration is not sufficient to establish a *prima facie* case of obviousness.

Obviousness Rejection Based on Dagan, as relied upon above, and further in view of U.S. Patent No. 6,780,924 to Shih *et al.* and U.S. Patent No. 6,777,039 to Koike *et al.*

Claims 1 through 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dagan, as relied upon above, and further in view of Shih *et al.* (U.S. Patent No. 6,780,924) (hereinafter “Shih”) and Koike *et al.* (U.S. Patent No. 6,777,039) (hereinafter “Koike”). Applicants respectfully traverse this rejection, as hereinafter set forth.

Regarding claim 1, Applicant asserts that Dagan, Shih, and Koike, assuming combinability for the sake of argument, do not teach or suggest all of the claim limitations of independent claim 1 to establish a *prima facie* case of obviousness regarding the invention of claim 1 under 35 U.S.C. § 103, for all of the reasons discussed above with regard to the Section 102 rejections, as Shih and Koike do not overcome the previously stated deficiencies of Dagan. Therefore, claim 1 is non-obvious. Claims 2 through 4 are non-obvious for at least the reason of depending from claim 1.

Obviousness Rejection Based on Dagan, as relied upon above, and further in view of U.S. Patent No. 6,936,316 to Nigam *et al.*

Claims 1 through 3, 6, and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dagan, as relied upon above, and further in view of Nigam *et al.* (U.S. Patent No. 6,936,316) (hereinafter “Nigam”). Applicants respectfully traverse this rejection, as hereinafter set forth.

Regarding claim 1, Applicant asserts that Dagan and Nigam, assuming combinability for the sake of argument, do not teach or suggest all of the claim limitations of independent claim 1 to establish a *prima facie* case of obviousness regarding the invention of claim 1 under 35 U.S.C. § 103, for all of the reasons discussed above with regard to the Section 102 rejections, as Nigam does not overcome the previously stated deficiencies of Dagan. Therefore, claim 1 is non-obvious. Claims 2, 3, 6, and 7 are non-obvious for at least the reason of depending from claim 1.

Rejoinder

Upon allowance of claims 1 through 4, 6, and 7 (product claims), rejoinder and allowance of claims 9, 11 through 16, and 18 through 20 (method claims), is respectfully

requested as allowed by M.P.E.P. § 821.04(b).

CONCLUSION

Claims 1 through 4, 6, 7, 9, 11 through 16, and 18 through 20 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,



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